

## REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF *WYETH*\*

Attorney Docket  
Number: **ZP192-10074**

Application  
Number: **10/690,211**

Filing Date  
(or 371(b) or (f) Date): **October 21, 2003**

Patent Number: **7,588,588**

Issue Date: **September 15, 2009**

First Named  
Inventor: **James Spitler**

Title: **System and Method for Stabilizing of Internal Structures**

PATENTEE HEREBY REQUESTS RECALCULATION OF THE PATENT TERM ADJUSTMENT (PTA) UNDER 35 USC 154(b) INDICATED ON THE ABOVE-IDENTIFIED PATENT. THE PATENTEE'S SOLE BASIS FOR REQUESTING THE RECALCULATION IS THE USPTO'S PRE-*WYETH* INTERPRETATION OF 35 U.S.C. 154(b)(2)(A).

Note: This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-*Wyeth* interpretation of 35 U.S.C. 154(b)(2)(A). See Instruction Sheet on page 2 for more information.

Patentees are reminded that to preserve the right to review in the United States District Court for the District of Columbia of the USPTO's patent term adjustment determination, a patentee must ensure that he or she also takes the steps required under 35 U.S.C. 154(b)(3) and (b)(4) and 37 CFR 1.705 in a timely manner.

\**Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

Signature **/Eric L. Killmeier/**

Date **March 5, 2010**

Name  
(Print/Typed) **Eric L. Kilmeier**

Registration Number **55,327**

**Note:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below\*.



\*Total of \_\_\_\_\_ forms are submitted.

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**Instruction Sheet for:  
REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT  
IN VIEW OF *WYETH*\***

(Not to be Submitted to the USPTO)

**This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-*Wyeth* interpretation of 35 U.S.C. 154(b)(2)(A).**

**This form must be filed within 180 days of the day the patent was granted, with the following exception:**

Patentees who received a decision from the USPTO under the USPTO's pre-*Wyeth* interpretation of 35 U.S.C. 154(b)(2)(A) may file a request for reconsideration of that decision if such a request for reconsideration is filed within **two months** of the date of the decision (37 CFR 1.181(f)). If the patentee's sole basis for requesting reconsideration of the decision is the USPTO's pre-*Wyeth* interpretation of 35 U.S.C. 154(b)(2)(A), the request for reconsideration need only state that reconsideration is being requested in view of *Wyeth* (this form may be used for this purpose if it is filed within **two months** of the date of the decision from the USPTO).

**Do not use this form if the application has been allowed, but not yet issued as a patent.**

- 1. For patents issued before March 2, 2010:** A request for reconsideration under 37 CFR 1.705(d) and the fee set forth in 37 CFR 1.18(e) are not required, provided that the patentee's sole basis for requesting recalculation of the PTA in the patent is the USPTO's pre-*Wyeth* interpretation of 35 U.S.C. 154(b)(2)(A) and this form is filed within 180 days of the day the patent was granted.
- 2. For patents issued on or after March 2, 2010 (do not use this form):** Patentees seeking a revised PTA in a patent issued on or after March 2, 2010, must file a request for reconsideration under 37 CFR 1.705(d) that complies with the requirements of 37 CFR 1.705(b)(1) and (b)(2) within two months of the day the patent issued.

For more information, see "Notice Concerning Calculation of the Patent Term Adjustment With Respect to the Overlapping Delay Provision of 35 U.S.C. 154(b)(2)(A)" available on the USPTO Web site at <http://www.uspto.gov/patents/law/notices/2010.jsp>.

\**Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:	)	Attorney Ref.: ZP192-10074
	)	
Inventor: James SPITLER, <i>et al.</i>	)	Patent No.: 7,588,588
	)	
Application No.: 10/690,211	)	Issued: September 15, 2009
	)	
For: System and Method for Stabilizing of Internal Structures	)	Date Submitted: March 5, 2010
	)	

**Mail Stop PATENT EXT.**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF *WYETH***

Dear Sir:

The following remarks are submitted in support of the Applicants' request for recalculation of the patent term adjustment ("PTA") and in conjunction with Form PTO/SB/131 submitted herewith. The recent decision in *Wyeth v. Kappos*, 591 F.3d 1364, interpreted 35 U.S.C. § 154(b) and found that the Patent Office has been incorrectly determining PTA's. The PTA calculated by the Office prior to the *Wyeth* decision for the above-cited patent is 343 days. The Applicants, however, contend that the PTA should be 709 days and offer an explanation for this number below. No fees are believed to be due with this submission. Also, no Terminal Disclaimer was filed during the prosecution of the present patent.

The *Wyeth* court construed 35 U.S.C. § 154(b) to be understood by a simple equation: delays by the Patent Office missing a variety of deadlines as prescribed by 35 U.S.C. § 154(b)(1)(A) ("A Delays") plus delays by the Patent Office for not issuing a patent within three years of the filing days as prescribed by 35 U.S.C. § 154(b)(1)(B) ("B Delays") minus the number of days due to A Delays that also overlap the B Delays ("Overlap") minus the Applicants' Delays equals the PTA. In other words:

$$PTA = A \text{ Delays} + B \text{ Delays} - \text{Overlap} - \text{Applicants' Delay}$$

It should be noted that all delays are measured in terms of days.

The table in Appendix A, submitted herewith, outlines the relevant dates of various actions by the Office and the Applicants that occurred during the prosecution of the present patent, which may have resulted in delays of one form or another. As summarized in the table, the only A Delays were due to the Patent Office issuing a first action 366 days after fourteen months had passed from the initial filing of the present patent.

The B Delays total 586 days. This number comes from the fact that, because the patent did not issue until September 15, 2009, the Patent Office missed the three-year deadline prescribed by 35 U.S.C. § 154(b)(1)(B) by 1,060 days. However, the same statute limits this delay to time consumed by, *inter alia*, the filing of a Request for Continued Examination (“RCE”). Therefore, because the Applicants filed an RCE on May 29, 2008, the B delays will be reduced by 474 days. In other words, the total B Delays are 586 total days.

No A Delays overlapped with any B Delays. Therefore the Overlap is zero.

The Applicants delayed a total of 243 days. Sixty-one days of Applicants’ Delay were due to filing a response to the second action 61 days beyond the three-month shortened statutory period ended. Another 90 days were consumed because the Applicants filed an RCE to the fifth action 90 days after the three-month shortened statutory period ended. In addition, another 92 days accrued when then Applicants filed a response to the sixth action 92 days after the three-month shortened statutory period ended. Therefore, the sum Applicants’ Delay is 243 days.

Therefore, the total Patent Term Extension, which is reflected in the bottom line of the table, is 709 days. Expressed in the *Wyeth* equation: 366 days (A Delay) + 586 days (B Delay) – 0 days (Overlap) – 243 days (Applicants’ Delay) = 709 days.

Accordingly, the Applicants respectfully request that the PTA be adjusted to 709 days.

Respectfully submitted,

**MIDDLETON REUTLINGER**

Date: March 5, 2010

/ Eric L. Killmeier /  
Eric L. Killmeier  
Registration No. 55,327  
401 South Fourth Street  
2600 Brown & Williamson Tower  
Louisville, KY 40202  
(502) 625-2748 direct phone  
(502) 561-0442 fax  
elk@middreut.com

**Appendix A**

Activity	Date	A Delay	B Delay	Overlap	Applicants' Delay
Filing Date:	October 21, 2003	366			
First Action (Restriction):	December 22, 2005				
First Action Deadline:	December 21, 2004				
Response to 1A:	March 22, 2006				
Response to 1A Deadline:	March 22, 2006				
Second Action (Non-Final):	April 21, 2006				
Second Action Deadline:	July 22, 2006				
Response to 2A:	September 20, 2006				
Response to 2A Deadline:	July 21, 2006				
Third Action (Non-Final):	December 29, 2006				
Second Action Deadline:	January 20, 2007				
Response to 3A:	March 28, 2007				
Response to 3A Deadline:	March 29, 2007				
Fourth Action (Non-Final):	June 14, 2007				
Fourth Action Deadline:	July 28, 2007				
Response to 4A:	September 14, 2007				
Response to 4A Deadline:	September 14, 2007				
Fifth Action (Final):	November 29, 2007				
Fifth Action Deadline:	January 14, 2008				
Response to 5A (RCE):	May 29, 2008				
Response to 5A Deadline:	February 29, 2008				
Sixth Action (Non-Final):	August 20, 2008				
Sixth Action Deadline:	September 29, 2008				
Response to 6A:	February 20, 2009				
Response to 6A Deadline:	November 20, 2008				
NOA:	May 26, 2009				
NOA Deadline:	June 20, 2009				
Issue Fee Paid:	August 5, 2009				
Issue Fee Deadline:	August 26, 2009				
Issue Date:	September 15, 2009				
Issue Date Deadline:	December 5, 2009				
Three year deadline:	October 21, 2006		1060		
First RCE Filed:	May 29, 2008		-474		
Delay Totals:		366	586	0	-243
Term Adjustment (days):		<b>709</b>			